

### **REMARKS**

This is a reply to the Office Action mailed April 30, 2008. Applicant thanks the Examiner for carefully considering the present application.

#### **Drawings**

Figure 5 is objected as the Examiner perceives the zig-zag joints are angled. Applicant submits a replacement sheet for new Figure 5 to overcome the objections.

Figures 4 and 5 are objected to as requiring bracketing. Applicant submits replacement sheets for new Figures 4 and 5 including bracketing.

Figures 6, 9 and 10 are objected to as failing to show lines of the joints. Applicant submits that an ordinary person skilled in the art of lamination would know that the “lines” of the top joints when viewed are not noticeable as the angle of the two joining pieces and the wood grain camouflage the marks, unlike the joining marks on the front face of the joined blocks. Additionally, in figure 6 there are no joinder lines illustrated as the wood has been marked. In Figures 9 and 10, the lines of the joints are not clearly visible as a result of shuffling and cutting in accordance with embodiments of the claimed invention, as further explained below. Therefore, Applicant has not added faint indications of joinder lines.

Figure 8 has been deleted even though figure 8 represents a shuffled version of figure 7. Figures 9 and 10 have been amended as figures 8 and 9. Applicant submits replacement sheets for these figures 8 and 9. Applicant has also amended the specification accordingly.

Approval is respectfully requested.

### **Status of Claims**

Claims 7, 10, 12-13, 15-17 and 20-28 are currently pending. Claims 7, 13, 22 and 23 are independent.

Claims 10-12, 20-21, 24 and 27 are objected to for informalities. Claims 8, 10, 12 and 23-28 are rejected under 35 U.S.C. §112, first paragraph as failing to comply with the enablement requirement. Claims 22, 23 and 27-28 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent no. 947,001 issued to Kertscher ("Kertscher"). Claims 7, 10, 12-13, 15-17 and 20-28 are rejected under 35 U.S.C. §103(a) as being unpatentable over Applicant's admitted prior art in view of Kertscher.

### **Claim Amendments**

Claims 7, 10, 12-13, 22-24 and 27-28 are amended for clarification. No new matter has been added by way of these amendments.

### **Claim Objections**

Claims 20 and 21 are objected to for improper dependency. This objection is respectfully traversed. Claims 20 and 21 depend from claims 7 and 13, respectively. Claims 7 and 13 each require, in part, the second parallel planes being generally transverse to the first parallel planes. The phrase "transverse," as defined in the Merriam-Webster Dictionary for example, should be construed as "being across." Thus, claims 7 and 13 should be construed as requiring the second parallel planes being generally across, i.e., non-parallel to, the first parallel planes. Claims 20 and 21 further limit the "transverse" to be "perpendicular," and thus properly depend from

claims 7 and 13, respectively. An ordinary person skilled in the art would understand the plain meaning of the terms and that claims 20 and 21 narrow their respective independent claims.

Claims 10, 12, 24 and 27 are objected to for informalities. Applicant has amended claims 10, 12, 24 and 27 to overcome the informal objections.

Accordingly, withdrawal of the objections to claims 10, 12, 20, 21, 24 and 27 are respectfully requested.

### **Rejections under 35 U.S.C. 112**

Claims 8, 10, 12 and 23-28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The instant Office Action asserts that the specification fails to adequately describe/enable hidden joining marks. The rejection is respectfully traversed.

Applicant notes that the additional steps of rejoining and cutting the block in a transverse plane cannot hide these joins. Applicant respectfully disagrees. The independent claims as amended simply require that “joining the face planes of the first slats *in an order different than the first order*, ...” such that “the joining marks are substantially hidden in the wood slat” resulting from cutting in a transverse plane the shuffled first slats. The claims do not specifically require how to join “the face planes of the first slats *in an order different than the first order*.” However, as known to those of ordinary skill in the art, many ways of shuffling the order of the first slats exist. The claims require that after shuffling and re-cutting in a transverse plane the joining marks can be substantially unnoticeable. Further, Applicant submits that an ordinary person skilled in the art of lamination would know that the “lines” of the top joints when viewed are not noticeable as the angle of the two joining pieces and the wood grain camouflage the

marks when the block is transversely cut to form the wood slats, unlike the joining marks on the front face of the joined blocks as with the prior art.

In view of the above, all the independent claims as amended comply with the enablement requirement.

Accordingly, withdrawal of the rejection is respectfully requested.

Claims 23-28 are additionally rejected under 35 U.S.C. 112, second paragraph, as being indefinite. Applicant respectfully traverses the rejection.

Applicant notes that placing the slats in a different order shuffles the dovetail marks from being in a constant or similar position along the top of the formed block. As would be known to an ordinary person skilled in the art, this can easily be done by turning the slats 180 degree and reordering. As the wood has a grain that will vary throughout the width of the formed block, and by cutting the block transversely, the joining marks are substantially unnoticeable in the finished slat.

Accordingly, withdrawal of the rejection is respectfully requested.

#### **Rejections under 35 U.S.C. §102 (b)**

Claims 22-23 and 27-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Kertscher. The rejection is respectfully traversed because the claims include limitations not taught or suggested by Kertscher.

According to MPEP §2131,

'[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.' (Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). 'The identical invention must be shown in as complete

detail as is contained in the ... claim.’ (Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). The elements must be arranged as required by the claim, but this is not an ipsissimis verbis test, *i.e.*, identity of terminology is not required. (In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990)).

The claimed invention is directed to a wood product with unnoticeable joined markings. A bulk section of wood resulting from rejoining shorter blocks of wood have undesirable joining marks appearing in a face plane. By slicing the bulk section of wood along first parallel planes in a successive first order to form a plurality of first slats each having a face plane, joining the face planes of the first slats in an order different than the first order (e.g., shuffle the first slats) to create a new bulk section in the form of a laminate, and cutting the new bulk section along second parallel planes to form the wood slat, the second parallel planes being generally transverse to the first parallel planes, embodiments of the invention advantageously achieve wood slats in which the joining marks are substantially unnoticeable.

Claim 22 requires, in part,

multiple first manufactured wood slats formed from *cutting joined blocks of wood with zig-zag joining points between the blocks*, each first manufactured wood slat having a first face plane and *at least one zig-zag joining line exposed on the first face plane*, the multiple first manufactured wood slats being re-ordered and laminated together and sliced along a direction perpendicular to the first face planes of the first manufactured wood slats to produce second manufactured wood slats each having a second face plane free of any exposed zig-zag joining lines.

Claim 23 requires, in part,

the face being defined by periphery edges of a plurality of first manufactured slats each having a face plane containing joining marks in an undesirable pattern, and wherein the face planes being generally transverse to the periphery edges of the first

manufactured slats so that the undesirable patterns of the joining marks are not noticeable in the face of the finished wood slat.

By contrast, Kertscher does not deal with providing a first bulk section of wood having joining marks that appear in a face plane, the joining marks resulting from rejoining shorter blocks of wood to form the bulk section. In Kertscher, there are no bulk sections formed of shorter blocks of wood. Kertscher uses complete and solid boards. Therefore, there could never be a zig-zag joining line in Kertscher or a joining mark.

Further, Kertscher fails to show or suggest at least the claimed face being defined by periphery edges of a plurality of first manufactured slats each having a face plane containing joining marks in an undesirable pattern as required by amended independent claim 23.

More specifically, Kertscher is completely silent with respect to “joining marks” resulting from rejoining shorter blocks or wood to form the bulk section as required by amended independent claims of the present application. Without any joining marks in the starting bulk section of wood shown in Fig. 1, it is not surprising that Kertscher does not intend to hide such marks. The boards in Fig. 1 are clearly marked with certain orders, “a, b, c, d, e, ...,” such order being preserved in the step of cutting in a perpendicular direction in Fig. 3.

Regarding the assertions made in the instant Office Action with respect to the product-by-process claims, Applicant further respectfully submits that the claimed product results from a bulk section of wood having undesirable joining marks, such joining marks being “substantially unnoticeable” in the finished wood slat. As known to those of ordinary skill in the art, being “substantially unnoticeable” does not mean that traces indicating the original joining marks are non-existent. By contrast, Kertscher clearly shows that there are no joining marks in the first

place. Accordingly, the finished product of Kertscher has no traces whatsoever of such joining marks.

In view of the above, Kertscher fails to show or suggest the claimed invention as recited in independent claims 7, 13, 22 and 23. Thus, these independent claims are patentable over Kertscher for at least the reasons discussed above. Dependent claims are allowable for at least the same reasons. Accordingly, withdrawal of the rejection is respectfully requested.

Therefore, since Kertscher does not teach, disclose or suggest all of Applicant's amended claims 22 and 23 limitations, Applicant respectfully asserts that a *prima facie* rejection under 35 U.S.C. § 102(b) has not been adequately set forth relative to Kertscher. Thus, Applicant's amended claims 22 and 23 are not anticipated by Kertscher. Additionally, the claims that directly or indirectly depend on claim 23, namely claims 27 and 28, are also not anticipated by Kertscher for the same reason.

Accordingly, reconsideration and withdrawal of the 35 U.S.C. § 102(b) rejections for claims 22, 23 and 27-28 are respectfully requested.

#### **Rejections under 35 U.S.C. §103 (a)**

Rejection of claims 7, 10, 12-13, 15-17 and 20-28 under §103(a) as being unpatentable over Kertscher in view of Applicant's admitted prior art (AAPA) is respectfully traversed because the claims include limitations not taught or suggested by the cited references, whether considered separately or in combination.

According to MPEP §2142

[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co.*

*v. Teleflex Inc.*, 550 U.S. \_\_\_, \_\_\_, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that ‘rejections on obviousness cannot be sustained with mere conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.’ *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR*, 550 U.S. at \_\_\_, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval).

Further, according to MPEP §2143, “[T]he Supreme Court in *KSR International Co. v. Teleflex, Inc.* 550 U.S. \_\_\_, \_\_\_, 82 USPQ2d 1395-1397 (2007) identified a number of rationales to support a conclusion of obviousness which are consistent with the proper “functional approach” to the determination of obviousness as laid down in *Graham*.” And, according to MPEP §2143.01, [o]bviousness can be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so. *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1335 (Fed. Cir. 2006). Further, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art.” *KSR International Co. v. Teleflex, Inc.* 550 U.S. \_\_\_, \_\_\_, 82 USPQ2d 1385, 1396 (2007). Additionally, according to MPEP §2143

[a] statement that modification of the prior art to meet the claimed invention would have been “well within the ordinary skill of the art at the time the claimed invention was made” because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Pat. App. & Inter. 1993).

Applicant’s amended claim 7 requires, in part,

providing a first bulk section of wood having joining marks that appear in a face plane, the joining marks resulting from rejoining shorter blocks of wood to form the bulk section; cutting the first bulk section along first parallel planes in a successive first order to form a plurality of first slats each having a face plane; *joining the*



*face planes of the first slats in an order different than the first order to create a new bulk section in the form of a laminate; and cutting the new bulk section along second parallel planes to form the wood slat, the second parallel planes being generally transverse to the first parallel planes such that the joining marks are substantially unnoticeable in the wood slat (emphasis added).*

Applicant's amended claim 13 requires, in part,

*cutting successive sections of the bulk section of wood, the sections defining first parallel planes and forming a plurality of individual wood pieces; rejoining the plurality of individual wood pieces in a different order to form a new bulk section; and cutting the new bulk section along second parallel planes, the second parallel planes being transverse to the first parallel planes so that the wood slat has a desirable veneer appearance that the joining marks are substantially unnoticeable in the wood slat (emphasis added).*

Applicant's amended claim 22 requires, in part,

*multiple first manufactured wood slats formed from cutting joined blocks of wood with zig-zag joining points between the blocks, each first manufactured wood slat having a first face plane and at least one zig-zag joining line exposed on the first face plane, the multiple first manufactured wood slats being re-ordered and laminated together and sliced along a direction perpendicular to the first face planes of the first manufactured wood slats to produce second manufactured wood slats each having a second face plane free of any exposed zig-zag joining lines, the second manufactured wood slats being the finished wood slat.*

Applicant's amended claim 23 requires, in part,

*the final face being defined by periphery edges of a plurality of first manufactured slats each having a face plane containing joining marks in an undesirable pattern, and wherein the face planes being generally transverse to the periphery edges of the first manufactured slats so that the undesirable patterns of the joining marks are not noticeable in the final face of the finished wood slat (emphasis added).*

AAPA discloses the formation of slats that have zig-zag join marks on a face. Kertscher discloses changing the grain for complete boards. Neither Kertscher or AAPA are concerned with making the zig-zag joining marks unnoticeable. Further, there is a large difference between a board and a slat. Additionally, the purpose of Kertscher is so different from that of AAPA that any combination would fail. Any transverse cut on the block of AAPA would not result in a worthwhile product as the new face is marked (see Applicant's FIG. 6, ref. 4). If either prior art is combined with one another the result would change the principle of operation (see MPEP 2143.01 VI, "[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)).

None of the disclosures of AAPA or Kertscher teach, discloses or suggests all of Applicant's amended claims 7, 13, 22 and 23 limitations. Therefore, even if AAPA were combined with Kertscher, the resulting invention would still not include all of Applicant's claimed limitations. And, therefore, there would be no motivation to combine AAPA with Kertscher. Moreover, by viewing the disclosures of AAPA and Kertscher, one can not jump to the conclusion of obviousness without impermissible hindsight. According to MPEP 2141.01, "[t]he requirement 'at the time the invention was made' is to avoid impermissible hindsight."

'[i]t is difficult but necessary that the decisionmaker forget what he or she has been taught ... about the claimed invention and cast the mind back to the time the invention was made (often as here many years), to occupy the mind of one skilled in the art.' *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

Further, the assertions made in the Office Action on page 8 that lead to a conclusion of obviousness are not explicit and the basic requirements of an articulated rationale under MPEP 2143 cannot be found. Additionally, since neither AAPA, Kertscher, and therefore, nor the combination of the two, teach, disclose or suggest all the limitations of Applicant's amended claims 7, 13, 22 and 23, as listed above, Applicant's amended claims 7, 13, 22 and 23 are not obvious over AAPA in view of Kertscher since a *prima facie* case of obviousness has not been met under MPEP §2142. Additionally, the claims that directly or indirectly depend from amended claims 7, 13, 22 and 23, namely claims 10, 12, 15-17, 20-21, and 24-28 are allowable for at least the same reasons.

Accordingly, withdrawal of the rejection is respectfully requested.

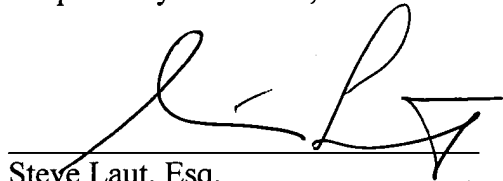
I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on July 24, 2008.

by Eric Hoover



Signature

Respectfully submitted,



Steve Laut, Esq.

Registration No. 47,736

Myers Dawes Andras & Sherman LLP  
19900 MacArthur Boulevard, 11<sup>th</sup> Floor  
Irvine, CA 92612

Tel: (949) 223-9600

Fax: (949) 223-9610

Customer No. 23386